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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEE, JOHN J

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 10/10/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,380

Applicant(s)

TERVO ET AL.

Examiner

JOHN J LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26,28-40,42-53 and 58-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,13-26,28-30,37-40,42-45,47-53,58 and 60-79 is/are rejected.
- 7) ☒ Claim(s) 7-12,31-36,46 and 59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments/amendments filed 7/7/2003 have been fully considered but they are not persuasive because the combined teaching of all the cited references as set forth in the previous rejection reads on all new amended limitation with claims (1-6, 13-26, 28-30, 37-40, 42-45, 47-53, 58, and 60-79).

The Examiner respectfully disagrees with Applicant's assertion that the reference of Phillips (US Patent number 6,188,898) does not teach the claimed invention "at least one property". Contrary to Applicant's assertion, Re claim 1, Phillips teaches for mobile terminal initiated/registered call (inherently recognizing that during the mobile terminal is registering, the mobile terminal send the own identification to base station), the terminal will emit a request for service on its frequency band according to its built-in operating protocol (this request signal is used by the network to determine the terminal's protocol) (see Fig. 3 and column 3, lines 30 - 64). More specifically, the request signal can be interpreted one of the properties. Furthermore, the claim does not require or limit the at least one property is information of own protocol.

Applicant's attention is directed to the rejection below for the reasons as to why the new limitation is not patentable.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Claims 37 and 38 depend on cancelled claim 27.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. **Claims 1-4, 6, 13-26, 28, 29, 37-40, 42-45, 47-53, 58, 61-65, and 67-79** are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips (US Patent number 6,188,898).

Regarding **claim 1**, Phillips discloses that a method for storing and informing at least one property (adapting to service mobile terminals having different operating protocols) of a wireless communication device (13 in Fig. 1) to a mobile communication network (Fig. 1) (Fig. 1, 2 and abstract) comprising:

storing information for identifying (by home location register 17 in Fig. 1) the wireless communication device (13 in Fig. 1) in the mobile communication network (Fig. 1) and information relating to at least one property (adapting to service mobile terminals having different operating protocols) of the wireless communication device (13 in Fig. 1) in an information frame (request frequency/signal) in a memory (inherently recognizing that the mobile terminal has a memory for storing the properties (example: program, names) of the wireless communication device (Fig. 1 and column 2, lines 64 – column 3, lines 10), said information frame (request signal) being arranged to store both of said information for identifying the wireless communication device (inherently recognizing that during the mobile terminal is registering, the mobile terminal send the own identification to base station) and said information relating to at least one property of the wireless communication device (Fig. 3 and column 3, lines 30 – 64); and

transmitting (request signal) said information for identifying the wireless communication device (13 in Fig. 1) and said information relating to at least one property of the wireless communication device from the wireless communication device to the mobile communication network (abstract, Fig. 1, 2, and column 2, lines 64 – column 4, lines 27). More specifically, Phillips teaches that the network includes multimode base stations each capable of operating selectively in at least some of said operating protocols and each having means for a mobile terminal so as to determine that terminal's operating protocol (abstract). If without informing own protocol information during the initiating communication time, the mobile network could not operate the service for a mobile

station. Therefore, the protocol is being employed by the requesting mobile terminal (see column 3, lines 36 – 55).

Regarding **claim 2**, Phillips discloses that the information relating to at least one property of the wireless communication device is transmitted from the wireless communication device to the communication network in connection with registration of the wireless communication device to the mobile communication network (abstract, Fig. 1, 2, and column 2, lines 64 – column 4, lines 27).

Regarding **claim 3**, Phillips discloses that the information relating to at least one property of the wireless communication device is transmitted from the wireless communication device to the communication network prior to a call being set-up with the wireless communication device (abstract, Fig. 1, 2, and column 3, lines 11 – column 4, lines 27).

Regarding **claim 4**, Phillips discloses that the information relating to at least one property of the wireless communication device is checked in the mobile communication network during call set-up with the wireless communication device to determine if the wireless communication device is able to receive and handle the call (abstract, Fig. 1, 2, and column 3, lines 11 – column 4, lines 27).

Regarding **claim 6**, Phillips discloses that the information relating to at least one property of the wireless communication device is transmitted to a mobile service-switching center of the mobile communication network, or a serving GPRS support node (abstract, Fig. 1, 2, and column 3, lines 11 – column 4, lines 27).

Regarding **claim 13**, Phillips discloses that the information relating to at least one property of the wireless communication device transmitted from the wireless communication device to the mobile communication network is stored at least in the mobile services switching center of the mobile communication network (Fig. 1, 2 and column 3, lines 11 – column 4, lines 27).

Regarding **claim 14**, Phillips discloses that the information relating to at least one property of the wireless communication device transmitted from the wireless communication device to the mobile communication network is stored temporarily in the mobile communication network (Fig. 1, 2 and column 3, lines 11 – column 4, lines 27).

Regarding **claim 15**, Phillips discloses that the wireless communication device comprises a mobile phone (Fig. 1, 2 and column 3, lines 11 – column 4, lines 27).

Regarding **claim 16**, Phillips discloses that the wireless communication device comprises a Communicator that has the combined properties of a cellular mobile telephone and a personal digital assistant (Fig. 1, 2 and column 1, lines 10 – 44).

Regarding **claim 17**, Phillips discloses that the wireless communication device comprises a radio card (Fig. 1, 2 and column 1, lines 10 – 44).

Regarding **claim 18**, Phillips discloses that the information relating to at least one property of the wireless communication device contains information about the hardware properties of the wireless communication device (Fig. 1, 2 and column 1, lines 65 – column 2, lines 23).

Regarding **claim 19**, Phillips discloses that the information relating to at least one property of the wireless communication device contains information about the software

properties of the wireless communication device (Fig. 1, 2 and column 3, lines 41 – column 4, lines 27).

Regarding **claim 20**, Phillips discloses that the information relating to at least one property of the wireless communication device contains information about at least one preference of the user of the wireless communication device (Fig. 1, 2 and column 2, lines 64 – column 4, lines 27).

Regarding **claim 21**, Phillips discloses that modification of the information relating to at least one property of the wireless communication device by the user of the wireless communication device is prevented (Fig. 1, 2 and column 3, lines 36 – 64).

Regarding **claim 22**, Phillips discloses that establishing a call for transmitting information from another communication device to said wireless communication device, wherein the information is optimized for use by the wireless communication device in the mobile communication network, by using the information relating to at least one property of the wireless communication device transmitted from the wireless communication device to the mobile communication network (Fig. 1, 2 and column 2, lines 64 – column 4, lines 27).

Regarding **claim 23**, Phillips discloses that performing communication between the mobile communication network and another communication device, wherein the information relating to at least one property of the wireless communication device is transmitted to other communication device (Fig. 1, 2 and column 2, lines 64 – column 4, lines 27).

Regarding **claim 24**, Phillips discloses that performing communication between the communication network and another communication network, wherein the information relating to at least one property of the wireless communication device is transmitted to another communication network (Fig. 1, 2, column 2, lines 64 – column 3, lines 28 and column 4, lines 34 – column 5, lines 35).

Regarding **claim 25**, Phillips discloses that the information to be transmitted is converted into a format suitable for the wireless communication device in said other communication device (Fig. 1, 2 and column 2, lines 64 – column 4, lines 27).

Regarding **claim 26**, Phillips discloses that the information to be transmitted is converted into a format suitable for the wireless communication device in the communication network (Fig. 1, 2 and column 2, lines 64 – column 4, lines 27).

Regarding **claim 28**, Phillips discloses all the limitation, as discussed in claims 1 and 2.

Regarding **claim 29**, Phillips discloses all the limitation, as discussed in claims 1 and 3.

Regarding **claim 37**, Phillips discloses all the limitation, as discussed in claims 1 and 15.

Regarding **claim 38**, Phillips discloses all the limitation, as discussed in claims 1 and 16.

Regarding **claim 39**, Phillips discloses all the limitation, as discussed in claims 1 and 17.

Regarding **claim 40**, Phillips discloses all the limitation, as discussed in claims 1 and 25.

Regarding **claim 42**, Phillips discloses all the limitation, as discussed in claims 1 and 2.

Regarding **claim 43**, Phillips discloses all the limitation, as discussed in claims 1 and 3.

Regarding **claim 44**, Phillips discloses all the limitation, as discussed in claims 1 and 4.

Regarding **claim 47**, Phillips discloses all the limitation, as discussed in claims 1 and 13.

Regarding **claim 48**, Phillips discloses all the limitation, as discussed in claims 13 and 14.

Regarding **claim 49**, Phillips discloses a register and wherein information relating to at least one property of the wireless communication device transmitted to the mobile communication network from the wireless communication device is stored in said register (Fig. 1, 2 and column 3, lines 65 – column 4, lines 19).

Regarding **claim 50**, Phillips discloses all the limitation, as discussed in claim 23.

Regarding **claim 51**, Phillips discloses all the limitation, as discussed in claims 6 and 24.

Regarding **claim 52**, Phillips discloses all the limitation, as discussed in claims 1 and 22.

Regarding **claim 53**, Phillips discloses all the limitation, as discussed in claims 1 and 22.

Regarding **claim 58**, Phillips discloses all the limitation, as discussed in claim 1.

Regarding **claim 61**, Phillips discloses all the limitation, as discussed in claims 1 and 22.

Regarding **claim 62**, Phillips discloses all the limitation, as discussed in claims 1 and 22.

Regarding **claim 63**, Phillips discloses that the other communication device is located in a communication network other than the mobile communication network (Fig. 1, 2 and column 2, lines 64 – column 3, lines 28).

Regarding **claim 64**, Phillips discloses all the limitation, as discussed in claims 22 and 63.

Regarding **claim 65**, Phillips discloses all the limitation, as discussed in claim 1.

Regarding **claim 67**, Phillips discloses all the limitation, as discussed in claims 1 and 18.

Regarding **claim 68**, Phillips discloses all the limitation, as discussed in claims 1 and 19.

Regarding **claim 69**, Phillips discloses all the limitation, as discussed in claims 1 and 20.

Regarding **claim 70**, Phillips discloses all the limitation, as discussed in claims 1 and 21.

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Regarding **claim 71**, Phillips discloses all the limitation, as discussed in claims 1 and 22.

Regarding **claim 72**, Phillips discloses all the limitation, as discussed in claim 1.

Regarding **claim 73**, Phillips discloses all the limitation, as discussed in claims 1 and 22.

Regarding **claim 74**, Phillips discloses all the limitation, as discussed in claims 22 and 61.

Regarding **claim 75**, Phillips discloses all the limitation, as discussed in claims 1 and 28.

Regarding **claim 76**, Phillips discloses all the limitation, as discussed in claims 1 and 22.

Regarding **claim 77**, Phillips discloses all the limitation, as discussed in claims 1 and 63.

Regarding **claim 78**, Phillips discloses all the limitation, as discussed in claims 1 and 25.

Regarding **claim 79**, Phillips discloses all the limitation, as discussed in claims 1 and 26.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 5, 30, and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips in view of Kuriki (US Patent number 5765105).

Regarding **claims 5, 30, and 45**, Phillips discloses all the limitation, as discussed claim 3. However, Phillips does not specifically disclose the limitation “connection with a handover”. However, Kuriki discloses “connection with a handover” (column 3, lines 35 – 55). It would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the Phillips system as taught by Kuriki. The motivation does so would be to improve quality of reception signal in order to further improve connection reliability in mobile communication system.

8. **Claims 60 and 66** are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips in view of Le et al. (US Patent number 6,556,820).

Regarding **claims 60 and 66**, Phillips does not specifically disclose the limitation “the information frame is further arranged to store information about peripheral devices connected to the wireless communication device”. However, Le discloses “the information frame is further arranged to store information about peripheral devices

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connected to the wireless communication device” (Fig. 5 and column 7, lines 65 – column 8, lines 20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Phillips system as taught by Le. The motivation does so would be to improve service program adaptability by peripheral devices in mobile communication system.

Allowable Subject Matter

9. Claims 7 – 12, 31 – 36, 46, and 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 7 – 12, 31 – 36, 46, and 59 the prior art fails to disclose “an International Mobile Station Equipment Identity (IMEI) is defined for said wireless communication device, and wherein the information relating to at least one property of the wireless communication device is stored in the IMEI” as specified in the claims 7 – 12, 31 – 36, 46, and 59.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baumeister et al. (US Patent number 6,618,595) discloses Process and Arrangement for Executing Protocols Between Telecommunications Devices in Wireless Telecommunications Systems.

Widegren et al. (US Patent number 6,374,112) discloses Flexible Radio Access and Resource Allocation in a Universal Mobile Telephone System.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(703) 306-5936**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay Aung Maung**, can be reached on **(703) 308-7745**. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L
October 03, 2003

John J Lee


NAY MAUNG
SUPERVISORY PATENT EXAMINER